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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/539,558      | 03/31/2000  | Alan H. Karp         | 10992073            | 9395             |

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FORT COLLINS, CO 80527-2400

EXAMINER

OUELLETTE, JONATHAN P

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3629

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/539,558

Applicant(s)

KARP ET AL.

Examiner

Jonathan Ouellette

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2000 and 30 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over O'Neil et al. (US 5,987,440).
3. As per independent Claims 1 and 14, O'Neil discloses a method (apparatus) for selling personal information (Abstract, C6 L53-64, C61 L43-60, C64 L61-67), comprising: receiving (receive module) personal information of an owner of the personal information (Abstract, C61 L50-54, C65 L36-39); specifying a policy (policy module) related to sale of the personal information (Abstract, C3 L49-63, C6 L53-64, C61 L61-67, C62 L61-67, C63 L1-15, C65 L39-40); validating (validate module) the personal information (Abstract, C7 L53-67, C8 L1-13, C63 L16-20, C67 L13-14, C70 L49-50); receiving a request for the personal information from a requestor; and selectively providing (provide module) the validated personal information in response to a request and based upon the policy (Abstract, C6 L53-64, C61 L55-60).
4. O'Neil does not specifically disclose enabling the requestor to decline receipt of the personal information based upon a cost of the personal information.

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5. However, O'Neil does teach that the buyer (requestor) has the right to collectively bargain collective and individual personal information processing privileges in exchange for value (C67 L62-67, C68 L1-5).
6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included enabling the requestor to decline receipt of the personal information based upon a cost of the personal information in the system disclosed by O'Neil, for the advantage of providing a method for selling personal information, which gives the buyer bargaining power to decide whether to purchase the personal information or not based on the seller's price.
7. As per Claims 2, 9, and 15, O'Neil discloses wherein the specifying the policy step includes specifying attributes required of a requestor in order to receive the personal information (Abstract, C10 L11-16, C24 L8-45, C65 L50-55, C67 L7-10).
8. As per Claims 3, 10, and 16, O'Neil discloses wherein the specifying the policy step includes specifying exclusions related to the sale of the personal information (Abstract, C24 L8-45, C67 L7-10).
9. As per Claims 4 and 17, O'Neil discloses specifying cost of the personal information, and wherein the providing step further includes selectively providing the validated personal information based upon the cost (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C61 L55-60).
10. As per Claims 5 and 18, O'Neil discloses wherein the providing step includes: assessing the cost to a requestor submitting the request; and crediting a least a portion of the cost to the owner (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).

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11. As per Claims 6 and 19, O'Neil discloses wherein the receiving step includes receiving information related to credit card purchases, shopping habits, web browsing habits, assets, or finances of the owner (Abstract, C6 L53-64, C10 L23-36).
12. As per Claims 7 and 20, O'Neil discloses wherein the receiving step includes recording an indication of electronic purchases by the owner (C6 L53-64, C10 L23-36, C21 L59-62, C63 L34-38).
13. As per independent Claim 8, O'Neil discloses a method for selling personal information (Abstract, C6 L53-64, C21 L37-62), comprising: receiving from a requestor a request for personal information of a particular owner of the personal information (Abstract, C7 L33-37, C24 L8-45); specifying a policy related to sale of the personal information; validating the personal information through a trusted third party (Abstract, C63 L16-20, C67 L13-14, C70 L49-50); determining if the requestor is permitted to receive the requested personal information based upon the policy; enabling the requestor to decline receipt of the personal information based upon a cost of the personal information (C67 L62-67, C68 L1-5); and providing the requested personal information to the requestor if the requestor is permitted to receive the personal information (Abstract, C6 L53-64, C61 L55-60) and has not declined receipt of the personal information based upon the cost (C67 L62-67, C68 L1-5).
14. As per Claim 11, O'Neil discloses providing payment to the owner for the sale of the personal information (Abstract, C6 L53-64, C10 L11-16, C21 L37-62, C62 L61-67, C66 L29-33).
15. As per Claim 12, O'Neil discloses wherein the providing step includes crediting an account associated with owner (Abstract, C6 L53-64, C21 L37-62, C62 L61-67).

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16. As per Claim 13, O'Neil discloses receiving a request for a particular owner having personal information for sale (Abstract, C7 L33-37, C24 L8-45).

***Response to Arguments***

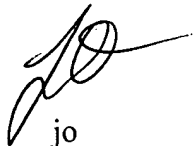
17. Applicant's arguments with respect to Claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.
18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

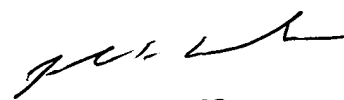
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21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



jo

November 13, 2002



**JOHN G. WEISS**  
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